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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/781,989	02/13/01	LAZARIDIS	555255012191

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TM31/0801

EXAMINER

EDELMAN, B

ART UNIT PAPER NUMBER

2153

DATE MAILED: 08/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/781,989

Applicant(s)

LAZARIDIS ET AL.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 5.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 6.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Requirement for Information Under 37 C.F.R. 1.105

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
2. The information is required to enter in the record the art suggested by the applicant as relevant to this examination in the Petition to Make Special Because of Actual Infringement Under 37 CFR 1.102 filed on May 4, 2001. In particular, the following material, declared to be known by applicant, must be disclosed:
 - a. Evidence, literature, and/or any other relevant material relating to the infringing device and method known by applicant to be actually on the market
 - b. A description and/or evidence that rigidly compares the alleged infringing device and method with the claims of the present patent application, as declared by applicant.
3. This information is required to identify in the record the art suggested by the applicant as relevant to this examination in the Petition to Make Special.

In response to this requirement, please provide or disclose any information known to be pertinent to the present application, as disclosed by applicant in the Petition to Make Special.

4. The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. 1.105 are subject to the fee and certification requirements of 37 C.F.R. 1.97.
5. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.
6. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or

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cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

7. This requirement is subject to the provisions of 37 C.F.R. §§ 1.134, 1.135, and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS UNDER THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 7, 8, 12, and 15-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S.

Patent No. 6,219,694. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

Claims 1 and 14 of the '694 patent contain all of the limitations of claim 7 of the present application (claim 14 discloses a "pager" which is the same as the "wireless device" claimed in claim 7 of the present application). It would have been obvious to a

person having ordinary skill in the art to leave out certain steps of '694 claims 1 and 14 in order to simplify the claimed system.

Furthermore, the wireless redirector component and the receiver and transmitter for receiving and transmitting messages from and to the wireless device, as claimed in the present invention but not claimed in the '694 patent, are inherent in the invention claimed in the '694 patent.

Claims 7 and 14 of the '694 patent contain all of the limitations of claim 8 of the present application.

Claim 14 of the '694 patent contains all of the limitations of claim 12 of the present application.

Claim 15 of the '694 patent contains all of the limitations of claim 15 of the present application.

Claim 8 and 9 of the '694 patent contain all of the limitations of claim 16 of the present application.

Claim 16 and 21 of the '694 patent contain all of the limitations of claim 18 of the present application.

Claim 19 of the '694 patent contains all of the limitations of claim 19 of the present application.

In considering claim 17 of the present application, although the claimed feature of including a command to enable the wireless redirector is not explicitly disclosed in the '694 patent, the '694 patent does disclose a command to enable or disable the preferred list (see claim 21 of the '694 patent). Thus the inclusion of a command to enable the

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entire wireless redirector would have been obvious to a person having ordinary skill in the art, so that all messages can be selectively forwarded or not forwarded to the mobile device.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In considering claim 9, the specification does not describe that the electronic envelope used to package messages for delivery between the first computer and the mobile device is addressed using *the first electronic address of the first computer system*. The specification describes that an electronic address of the mobile device is used to address the envelope when forwarding messages from the host to the mobile device. The specification further describes that a similar envelope packaging technique is used for messages sent from the mobile device to the host (see p. 17, lines 7-19). Such a "similar outer envelope" would include an address of the host system, but not necessarily *the first electronic address* referred to in the claim (i.e. the address used to make messages sent from either device appear the same).

In considering claim 20, the step of issuing a command to enable message encryption at the wireless redirector is not disclosed in the specification. Although the specification adequately describes various other commands, such as enabling redirection itself, and changing a preferred list at the wireless redirector, the specification does not describe enabling or disabling message encryption at the wireless redirector.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 7, 8, 10, 12, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ulrich et al. U.S. Patent No. 6,052,735 (hereinafter, "Ulrich").

In considering claim 7, Ulrich discloses a wireless mobile communications device (3) associated with a first computer system (4) identified by a first electronic address, wherein the first computer system includes a wireless redirector component for redirecting messages from the first computer system to the wireless mobile communications device (col. 4, lines 4-11, 53-59), comprising:

a receiver and memory for receiving and storing a redirected messages from the first computer system (inherent in the mobile device); and

a message generator and transmitter for generating and transmitting a reply message to the redirected message at the mobile device using the first electronic address of the first computer system as an originating address of the reply message (col. 11, line 59 – col. 12, line 7, wherein both devices are using the same e-mail account, and wherein reply messages are inherent in e-mail systems).

In considering claim 8, the steps of packaging the messages into electronic envelopes addressed using the electronic address of the mobile device prior to redirection, and unpackaging the messages from the electronic envelopes to thereby recover the messages, wherein the unpackaged messages appear to the user of the mobile communications device to have the same address format as the messages would appear to a user of the first computer system, is inherent in the system taught by Ulrich (both devices use a mirrored e-mail account, and messages must be packaged and unpackaged into envelopes when being sent between two devices).

In considering claim 10, Ulrich further discloses that the first computer is the user's desktop computer (fig. 1).

In considering claim 12, Ulrich further discloses that the mobile device can be a wireless pda or palm-top computer (col. 7, lines 40-44).

In considering claim 13, Ulrich further discloses a redirector component for redirecting messages received at the mobile communications device to the first computer system (col. 11, line 59 – col. 12, line 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich, and further in view of Kaufman (U.S. Patent No. 6,034,621).

In considering claim 14, Ulrich further discloses means for configuring one or more redirection events at the mobile device, means for detecting that one or more redirection events have occurred at the mobile device and for generating a redirection trigger (synchronization – col. 11, line 59 – col. 12, line 8).

However, Ulrich does not disclose the step of continuously redirecting messages from the mobile communication device to the first computer system. Nonetheless, such a system wherein messages are continuously redirected from a mobile device to a host system is well known, as evidenced by Kaufman. In a similar art, Kaufman discloses a system for redirecting messages between a desktop computer and a wireless mobile communication device, wherein data items are continuously forwarded between the two devices (col. 4, lines 28-35). Therefore, given the teaching of Kaufman, a person

having ordinary skill in the art would have readily recognized the desirability and advantages of forwarding the messages in the system taught by Ulrich on a continuous basis, as taught by Kaufman, to minimize the amount of data transfer necessary between data files at any one time (see Kaufman, col. 4, lines 38-40). Therefore, it would have been obvious to forward messages continuously, as taught by Kaufman, in the system taught by Ulrich.

5. Claims 7-9, 11, 12 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples et al. (U.S. Patent No. 5,764,639, hereinafter "Staples"), in view of Eggleston et al. (U.S. Patent No. 6,101,531, hereinafter "Eggleston").

In considering claim 7, Staples discloses a mobile communications device (102) associated with a first computer system identified by a first electronic address (corporate office, server 106), wherein the first computer system includes a redirector component for redirecting messages from the first computer system to the mobile communications device (col. 4, lines 23-37; col. 6, lines 22-25), comprising:

- a receiver (IRW unit 104) for receiving a redirected message from the first computer system (col. 4, lines 27-34);

- a memory for storing the redirected message (inherent in the mobile device);

- a message generator for generating a reply message to the redirected message at the mobile device using the first electronic address of the first computer system as an originating address of the reply message (col. 23, lines 11-13, wherein reply messages are an inherent function of e-mail); and

a transmitter (IRW unit 104) for transmitting the reply message to the first computer system.

Although the system taught by Staples teaches substantial features of the claimed invention, it fails to explicitly disclose that the mobile device is a wireless mobile device. Nonetheless, in column 5, lines 33-36, Staples suggests, "The remote computer system 102 used by the remote user may comprise either an analog modem 184 or an ISDN terminal adapter 182, *or another type of communications device* [emphasis added]." It is well known that wireless modems or other wireless communications means can be used in a mobile device for wireless communication with other devices, as evidenced by Eggleston. In a similar art, Eggleston discloses a wireless communication device (105) that receives and replies to messages redirected from a host computer system (115) through a wireless modem (106, see col. 4, lines 9-34; col. 3, lines 4-8), for the purpose of message filtering. Thus given the teaching of Eggleston, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using wireless devices in the system taught by Staples, so that users can connect to the network and receive the forwarded messages at any location. Therefore, it would have been obvious to use wireless devices, as taught by Eggleston, in the message redirection system taught by Staples.

In considering claim 8, Staples further discloses packaging the messages into electronic envelopes addressed using the electronic address of the mobile device prior to redirection, and unpackaging the messages from the electronic envelopes to thereby

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recover the messages, wherein the unpackaged messages appear to the user of the mobile communications device to have the same address format as the messages would appear to a user of the first computer system (col. 5, lines 37-47; col. 7, lines 28-33; col. 21, lines 31-50; col. 6, lines 19-44, wherein the "electronic address" and the "repackaging" are inherent in sending the message to the remote device).

In considering claim 9, as understood, Staples further discloses that message generator uses the first electronic address to generate the reply message (i.e. messages sent from the mobile device appear to have been sent from the host system – col. 23, lines 2-14).

In considering claim 11, Staples further discloses that the first computer is a network server computer system (col. 4, lines 35-37).

In considering claim 12, Staples further discloses that the mobile device can be a laptop, pda (i.e. palm-top computer), or mobile telephone. Again, it would have been obvious to a person having ordinary skill in the art for such devices to comprise wireless devices, as suggested by Eggleston, so that users can connect to the network from anywhere.

In considering claim 15, Staples further discloses that the mobile device can receive both voice and non-voice messages (col. 7, lines 19-27).

In considering claim 16, Staples further discloses generating one or more commands that control the redirector at the first computer system, wherein the transmitter transmits the one or more commands from the mobile communications device to the first computer system (col. 17, lines 1-17). Eggleston also discloses that the mobile device can send commands to the first computer system to control the redirector at the first computer system (Title; col. 8, lines 64-67).

In considering claim 17, Staples further discloses that the one or more commands includes a command to enable the wireless director (col. 17, lines 14-18; col. 21, lines 1-17).

In considering claims 18-19, Eggleston further discloses a preferred list at the host system which can be altered as claimed via the mobile device (col. 8, lines 22-67; col. 9, lines 11-16, 54-59).

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Staples and Eggleston, in view of Albert (U.S. Patent No. 5,452,356).

In considering claim 22, neither Staples nor Eggleston disclose an encryption and decryption mechanism for securely sending the messages between the first computer system and the mobile device. Nonetheless, such encryption/decryption mechanisms are well known in the art, as evidenced by Albert. In a similar art, Albert

discloses a system for sending data between a first computer system and a mobile communication device, wherein the data is encrypted and decrypted for security purposes (Abstract). Thus, given the teaching of Albert, a person having ordinary skill in the art would have readily recognized the desirability and advantages of encrypting and decrypting the messages sent between the mobile device and the first computer system taught by Staples and Eggleston, so that computer hackers could not easily gain intercept and interpret classified messages sent between the mobile device and the first computer system. Therefore, it would have been obvious to use encryption as taught by Albert in the message forwarding system taught by Staples and Eggleston.

7. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples and Eggleston, in view of Albert, and further in view of Caronni et al. (U.S. Patent No. 5,822,434, hereinafter "Caronni").

In considering claims 20-21, the combined system, as discussed above, discloses the claimed encryption and decryption modules for encrypting and decrypting messages sent from the first computer system to the mobile device. However, the combined system does not disclose including a command from the mobile device, which command enables the message encryption between the two devices. Nonetheless, it is well known in the art to allow two communicating computers to select between enabling and disabling encryption between the computers, as evidenced by Caronni. In a similar art, Caronni discloses a system for encrypting messages sent between two computer systems, wherein a host computer attempting to communicate with another host

computer can select to enable or disable encryption when communicating with the second host (col. 2, line 44 – col. 3, line 6; claim 1). Thus, given the teaching of Caronni, a person having ordinary skill in the art would have readily recognized the desirability and advantages of selecting whether or not to use encryption, as taught by Caronni, in the combined system taught by Staples, Eggleston, and Albert, so a user can selectively choose whether to speed up the transmission by disabling encryption, or to secure the transmission by enabling encryption. Therefore, it would have been obvious to include selective encryption, as taught by Caronni, in the encrypted message forwarding system taught by Staples, Eggleston, and Albert.

8. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples and Eggleston, in view of LaPorta et al. (U.S. Patent No. 6,014,429, hereinafter "LaPorta").

In considering claims 23 and 24, although the system taught by Staples and Eggleston teaches substantial features of the claimed invention, it fails to disclose that the mobile device can command the host system to perform a search and retrieval operation on a remote database. Nonetheless, such a remote search and retrieval operation is well known in the art, as evidenced by LaPorta. In a similar art, LaPorta discloses a system for forwarding messages from a host system to a wireless portable device, wherein the host system (user agent 12) can be programmed by the mobile device (11) to perform a search and retrieval from a database on the Web (col. 7, lines 55-60; col. 8, lines 15-25). Thus, given the teaching of LaPorta, a person having

ordinary skill in the art would have readily recognized the desirability and advantages of allowing search and retrieval functions to be remotely performed via the portable device disclosed by Staples and Eggleston, so that mobile users can search the Internet for directions, restaurants, or hotels in the vicinity of the user's location. Therefore, it would have been obvious to include a search and retrieval function, as taught by LaPorta, in the message forwarding system taught by Staples and Eggleston.

9. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples and Eggleston, in view of Tang et al. (U.S. Patent No. 5,630,060, hereinafter, "Tang").

In considering claims 25-26, although the system taught by Staples and Eggleston teaches substantial features of the claimed invention, it fails to disclose sending commands from the mobile device to the first computer system, which commands instruct the first computer to either send attachments to the mobile device, or else to send the attachments to other external devices. Nonetheless, such an attachment processing system is well known in the computer networking art, as evidenced by Tang. In a similar art, Tang describes an e-mail forwarding system wherein "multimedia components" or attachments which are part of an e-mail message, are sent over a medium, and ultimately to a device which is compatible with the attachment format (col. 1, lines 52-54; col. 1, line 67 – col. 2, line 19; col. 3, lines 1-4; col. 7, lines 19-25). Given the teaching of Tang, a person having ordinary skill in the art would have readily recognized the desirability and advantages of sending commands

from the mobile device to the computer system to instruct the computer system whether to forward attachments to the mobile device or to another device, so that while users of powerful devices, such as laptops, can conveniently receive attachments at their machines, while users of less powerful devices, such as hand-held pdas can still receive important attachments at external machines. Therefore, it would have been obvious to use the attachment processing method taught by Tang in the message forwarding system taught by Staples and Eggleston.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

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Conclusion

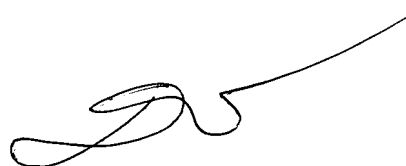
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

A handwritten signature in black ink, consisting of a series of loops and a long, sweeping line extending to the right.

Dung C. Dinh
Primary Examiner

BE
July 27, 2001